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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,566	03/02/2004	Axel E. Elfner	END920030098US1	3099
30400	7590	08/15/2008	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			POLLACK, MELVIN H	
		ART UNIT	PAPER NUMBER	
		2145		
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		08/15/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/791,566	ELFNER, AXEL E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MELVIN H. POLLACK	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 June 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 5-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-3 and 5-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)                           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application                 |
| Paper No(s)/Mail Date _____.   | 6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> . |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 June 2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 06 June 2008 have been fully considered but they are not persuasive. An analysis of the arguments is provided below.
3. The primary argument is that Afergan and Yoshida do not expressly disclose that the proxy checks to see if there is mail to be sent (Pp. 4-5). Afergan concentrates on generic content, but the structure clearly allows for a proxy to check for – and subsequently request – updates and content changes that can be analogized to changes in the mail data structures. Yoshida, which does teach a proxy that receives email, is even clearer (Para. 36).
4. The secondary argument is that Afergan and Yoshida are not analogous art (Pp. 5-8). Applicant further argues that examiner did not disclose how the items fit the test. Examiner disagrees, but will restate how the application fits the test. Applicant is urged to review the after-final advisory action.
5. Examiner starts by stating what analogous is not. It is not defined by the words and beliefs of the applicant, such that they may unconditionally narrow the field of endeavor or

reasonable pertinence to the problem to all but the closest 102 rejections. It is not a mere copy of the narrowest statement of the "field of the invention" section of the instant application's specification, nor can it be narrowed by the remarks of an amendment. Instead it is based on the broadest reasonable interpretation of the claims in the view of one of ordinary skill in the art, although the specification may be used to clarify the issues. The issues are also determined by one of ordinary common sense.

6. For example, In re ICON's instant application is drawn to a folding and movable treadmill, as stated in the field of the invention. The court found that a folding bed attached to a wall was analogous art, even though it lacked the ability to be moved or run upon. The fact that it related to one of the applicant's problems of interest - how to fold the object – was deemed sufficient.

7. In the instant case, the examiner considers the field of endeavor to be a combination of email systems and securing of a private network. The examiner further considers the issues reasonably pertinent to the problem to comprise the operation of a proxy server that restricts communication, the operation of a proxy server to request content of any type, the transmission of email through a firewall or proxy server, and so forth. Analogous art merely has to fit one of these categories – it does not have to fit all, and should not be confused with the test for obviousness.

8. Afergan is within the field of the Applicant's endeavor because it teaches the transmission of data through a restricted network. It is pertinent to the Applicant's problem because it teaches that a protected server that would otherwise be unable to transmit its data may do so through an external proxy unit, and shows how to do so without losing its protected

network status, one example of the protected server being a protected mail server on the restricted network.

9. Yoshida is within the field of the Applicant's endeavor because it teaches the coordination of a restricted mail server (center-side) with an external proxy (client-side) such that mail data may travel through a firewall. That it is concerned with mail system efficiency in addition to mail system security is irrelevant. It is relevant to the problem because it teaches that authentication methods may be used to keep the restricted network from being compromised, and does so via the process of interacting only with recognized external proxies (Para. 41).

10. If the applicant wishes to further pursue this argument, he may do so at the board of appeals.

11. The examiner has updated his search in light of the RCE, but maintains the rejections for the reasons above.

#### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3, 5, 6, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan et al. (2004/0010601) in view of Yoshida (2004/0049546).

14. For claim 1, Afergan teaches a method (abstract) of facilitating the sending of mail from a restricted communications network (Paras. 1-20), said method comprising:

- a. automatically checking periodically (Paras. 20-24) by a communications unit external (Fig. 4A, #406-410) to a restricted (Paras. 27-30) communications network (Fig. 4A, #400-404) whether mail (Para. 28; content particularized to example of mail server) of the restricted communications network is to be sent (Paras. 23-24); and
- b. retrieving by the communications unit the content (Para. 28) from the restricted communications network, in response to there being mail to be sent (Paras. 21-24);
- c. wherein the automatically checking comprises sending a request from a program of the communications unit to a program of the restricted communications network (Paras. 29-30) inquiring as to whether there is content to be sent, and wherein the program of the restricted communications network checks a data structure to determine whether there is content in the data structure to be sent (Paras. 23-35).

15. Afergan does not expressly disclose that the content being sent is mail messages, or that the system is checking in particular for mail messages to be sent. Yoshida teaches a method and system (abstract) of mail delivery (Paras. 1-23) through an external proxy server (Paras. 24-26) from a server on a restricted network (Paras. 27-32, 41). In particular, Yoshida checks periodically to see if there is new mail to be sent (bulk mail data 100) and retrieves it if there is (Paras. 33-39, 43). At the time the invention was made, one of ordinary skill in the art would have added Yoshida's mail server and content retrieval system to Afergan's content retrieval system with mail server embodiment in order to reduce Afergan's content network load stresses (Para. 5) and to further explain the mail server embodiment.

16. For claim 2, Afergan teaches wherein the sending of the request is via an inbound connection from the communications unit to the restricted communications network over an available port (Paras. 27-39, with emphasis on Paras. 28-29 and 32-34).

17. For claim 3, Afergan teaches that the retrieving comprises having the program of the restricted communications network serve the mail to the program of the communications unit via the available port (Paras. 27-39, with emphasis on Paras. 28-29 and 32-34).

18. For claim 5, Afergan teaches that the retrieving comprises having the program of the restricted communications network provide the mail in the data structure to the communications unit (Para. 28).

19. For claim 6, Afergan teaches providing the mail to the data structure (Para. 28).

20. For claim 8, Afergan teaches forwarding the mail (Para. 28) from the communications unit to one or more receivers (Paras. 23-24).

21. For claim 10, Afergan teaches that a receiver of the one or more receivers comprises an intermediary to facilitate forwarding the mail to an intended recipient of the mail (Paras. 23-24).

22. For claim 11, Afergan teaches that the forwarding comprises parsing the mail into one or more messages and sending the one or more messages to the one or more receivers (Paras. 21-25).

23. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and Yoshida as applied to claims 1, 6 above, and further in view of Banister et al. (7,219,131).

24. For claim 7, Afergan and Yoshida do not expressly disclose that the providing is performed by a queue program of the restricted communications network, and wherein the queue

program receives the mail from another program of the restricted communications network, said another program capable of receiving mail from one or more communications units of the restricted communications network. Banister teaches a method and system (abstract) of determining e-mails for appropriate delivery (col. 1, line 1 - col. 5, line 65; col. 20, line 33 - col. 28, line 25) that includes delivery decision making procedures (col. 5, line 65 - col. 20, line 33), and includes the queuing procedure (col. 10, line 50 - col. 12, line 40). At the time the invention was made, one of ordinary skill in the art would have added these features in order to protect from the security problem known as spam (col. 2, line 50 - col. 3, line 5).

25. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and Yoshida as applied to claims 1, 8 above, and further in view of Mizuno et al. (2006/0031927).

26. For claim 9, Afergan and Yoshida do not expressly disclose that a receiver of the one or more receivers comprises an intended recipient of the mail. Mizuno teaches a method and system (abstract) of transferring communications data (Paras. 1-25) from a restricted network to an external server (Paras. 26-30) that includes this limitation (Paras. 31-34). At the time the invention was made, one of ordinary skill in the art would have added Mizuno in order to improve seamless access to files behind an Afergan firewall (Paras. 13-14).

27. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and Yoshida as applied to claims 1, 8, 11 above, and further in view of Clarke et al. (7,043,240).

28. For claim 12, Afergan and Yoshida do not expressly disclose that the manner in which a message is sent to a receiver is dependent on the type of receiver. Clarke teaches a method and

system (abstract) of providing the messages (col. 1, line 1 – col. 3, line 55) that comprise the limitations (col. 3, line 55 – col. 7, line 30). At the time the invention was made, one of ordinary skill in the art would have added Clarke's receivers in order to handle a variety of legacy protocols (col. 1, lines 15-55).

***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They regard further teachings on email systems and secured networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melvin H Pollack/

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